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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/833,342	04/04/97	MAA	S 3807.2US

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QM12/0802

EXAMINER

PARADISO, J

ART UNIT

PAPER NUMBER

3713

14

DATE MAILED:

08/02/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary** *LB*Application No.  
**08/833,342**Applicant(s)  
**MAA**Examiner  
**John Paradiso**Group Art Unit  
**3713**☒ Responsive to communication(s) filed on Jul 2, 1999☒ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**☒ Claim(s) 35-60 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.☒ Claim(s) 35-60 is/are rejected.☐ Claim(s) \_\_\_\_\_ is/are objected to.☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### Continued Prosecution Application

1. The request filed on 5/10/99 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/831,342 is acceptable and a CPA has been established. An action on the CPA follows.

### Examiner's Amendment

2. An Examiner's Amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this Examiner's Amendment was given in a telephone interview with Dr. Shalong Maa on July 19, 1999.

3. The application has been amended as follows:
  - a) ~~C~~laims 1-28 have been canceled.
  - b) ~~C~~laims numbered 1-26, submitted on 7/2/99 as a Preliminary Amendment and entered as Paper # 13, have been renumbered as claims 35-60

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**Papers Entered**

4. A revocation of Power of Attorney was entered 6/11/99 as Paper No. 8 and Applicant is now administering the application *pro se*.

5. The following papers were entered on 7/2/99 as Paper No. 13:

- A substitute Specification
- A Preliminary Amendment, including 26 claims
- Remarks

6. For Applicant's convenience, any future changes to the Specification may be made by submitting an amendment indicating the page and location of any words to be amended, deleted, or added.

When submitting an amendment to a claim, the label "(amended)" should be typed after the claim number and the entire claim must be quoted as it appears on the record. Any additions must then be inserted and underlined; any deletions must be placed within square brackets.

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*Claim Rejections - 35 USC § 112*

7. Claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 42 lines 2-3, it is unclear what is meant by "means for transferring said external .. signal .. to a drive-control signal sequence..". It would appear that a signal can be transferred to a means for receiving it, not another sequence.

*Claim Rejections - 35 USC § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 35, 37, and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by TONG.

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TONG discloses an interactive, computer-controlled doll, as described in the previous Office Action, in which actuators to move the doll's body parts. TONG discloses providing a signal from the computer to the doll, which in turn moves the appropriate parts of the doll (mouth, arms, etc.) depending on whether the signal is present or not. Note that while the information within the signal is analog data, the dolls actuators respond to the presence or lack of the signal, taking not the audio data within, but the presence of the signal itself as a logic signal.

TONG also discloses (in embodiment in Fig. 6) a voice-recognition feature where the user can speak into a microphone and the computer will recognize the words and provide the appropriate signal(s) to the doll.

(See TONG columns 2-4 and figures 1 and 6.)

*Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 36 and 38-4 are rejected under 35 U.S.C. §103(a) as being unpatentable over TONG.

TONG discloses the claimed invention except for the actuators being comprised of a "solenoid means".

However, Applicant is given Official Notice that the use of solenoids as actuators for the movement of dolls and figures is well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect two-phase solenoids as the actuators in the invention of TONG in order to reduce the complexity and cost of the actuators and the invention.

12. Claims 44-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over TONG as applied to claims 36 and 38 above, and further in view of GASPER ET AL.

TONG substantially discloses the claimed invention except for specifically describing the "digital animation-control signal sequence being associated with selected audio speech ... and transmitted to the toy in synchronization with the transmission".

GASPER ET AL discloses a system for sound-synchronized animation for use in a game, as described in the previous Office Action. GASPER ET AL builds and saves its own dictionary file after determining the proper lip synchronization of an inputted

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word. GASPER ET AL also teaches different articulations for various sounds: silence, vowels, and consonants.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method of sound analysis used in GASPER ET AL in the invention of TONG in order to efficiently and accurately analyze and coordinate the inputted user sounds with the movement signals sent to the doll of TONG.

Examiner also notes that TONG does disclose the use of voice-recognition software to analyze inputted voice data. Examiner also notes that it is a standard programming technique to store inputted data of all types, including voice recognition data, in memory arrays for temporary use and in text files for permanent storage and later retrieval.



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*Response to Remarks*

13. Applicant's arguments filed 7/2/99 have been fully considered but they are not persuasive.

14. Applicant states on page 2 of his Remarks that "Tong utilizes a computer to only send an analog signal to the toy."

However, as explained above, TONG discloses providing a signal from the computer to the doll, which in turn moves the appropriate parts of the doll (mouth, arms, etc.) depending on whether the signal is present or not. Note that while the information within the signal is analog data, the dolls actuators respond to the presence or lack of the signal, taking not the audio data within, but the presence of the signal itself as a logic signal.

15. Applicant states on page 4 of his Remarks that TONG does not employ "an actuator having only two phases for moving said movable portion".

However, the solenoids described in paragraph 12 above do indeed inherently have two phases for moving a movable portion.

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16. Applicant states on page 5 of his Remarks that "Gasper does not disclose means for adjusting the frequency of the image-actuation control according to the reaction or response time of the moveable portion of the on-screen image..".

However, the claims do not recite adjusting the frequency of the image-actuation control in that manner.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to:



Examiner John Paradiso  
Telephone: (703) 308-2825  
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VALENCIA MARTIN-WALLACE  
PRIMARY EXAMINER

July 29, 1999